

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-30 are currently pending. Claims 1, 9, 11, 15, 17, 19-26, and 30 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1, 2, 10-12, and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,069 to Honma (hereinafter “the ‘069 patent”) in view of U.S. Patent Application Publication No. 2007/0046993 to Sato (hereinafter “the ‘993 application”) and U.S. Patent Application Publication No. 2002/0186408 to Nakaoka et al. (hereinafter “the ‘408 application”); Claims 24-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘069 patent; Claims 3, 5, 6-8, 13, and 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘069 patent in view of the ‘993 application, the ‘408 application, and U.S. Patent No. 6,785,812 to Botham, Jr., et al. (hereinafter “the ‘812 patent”); Claims 4 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘069 patent in view of the ‘993 application, the ‘408 application, and U.S. Patent No. 6,233,618 to Shannon (hereinafter “the ‘618 patent”); Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘069 patent in view of the ‘993 application, the ‘408 application, and in view of U.S. Patent Application Publication No. 2002/0174010 to Rice, III (hereinafter “the ‘010 application”); and Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘069 patent in view of the ‘993 application, the ‘408 application, the ‘618 patent, and the ‘010 application.

STATEMENT OF SUBSTANCE OF INTERVIEW

Applicants wish to thank Examiner Mai for the telephone discussion with Applicants' representative on February 18, 2009, at which time the grounds of rejection for Claims 24-30 were discussed. The Examiner indicated that Claim 24-30 were inadvertently indicated as being rejected under 35 U.S.C. § 103(a) as being unpatentable over the '069 patent, the '993 application, and the '408 application, rather than under 35 U.S.C. § 103(a) as being unpatentable over the '069 patent.

REJECTION UNDER 35 U.S.C. § 103

Claim 1 is directed to a file transfer system, comprising:

a file management server comprising a web page configured to manage a transfer of files and to allow the files to be accessed subject to a first password through the web page;

a file transmitting terminal configured to store a file and a second password for accessing the file, *the second password being associated with the file*;

a file receiving terminal; and

a mobile terminal,

wherein

said file management server, said file transmitting terminal, said file receiving terminal, and the mobile terminal are connected to each other via a network;

said file transmitting terminal is configured to transmit, to said file management server, the file and the second password as a part of an authentication condition for accessing the file, through the web page;

said file management server is configured to store and to correlatingly manage the file and the second password transmitted from said file transmitting terminal;

said mobile terminal is configured to transfer an address of a particular file receiving terminal that is permitted to access the file, to said file management server through the web page;

said file management server is configured to store and to correlatingly manage the address of said particular file receiving terminal with the file;

said file receiving terminal is configured to transmit to said file management server a request for transferring the file; and

in response to the request transmitted by said file receiving terminal, if an address of said file receiving terminal and the address of the particular file receiving terminal transferred by the mobile terminal are determined to match, and if the request transmitted by said file receiving terminal is determined to include the second password, said file management server is configured to transfer the file to said file receiving terminal.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the '069 patent is directed to an image forming system including an image forming apparatus that communicates with other apparatuses for data exchange.¹ In particular, the '069 patent discusses that, in response to pressing of an other device key 805, on a control panel 500 of the image-forming apparatus 1000, a CPU 323 searches for other image-forming apparatuses which can exchange data with the image-forming apparatus 1000, and displays the search results on a list on the screen. The '069 patent discusses that the user, who has pressed the other device key 805, selects an image-forming apparatus having a personal box storing a desired job, referencing the screen shown in Fig. 15, looks into the personal box of the selected apparatus, selects desired original document image data, transfers the original document image data from the image-forming apparatus selected in Fig. 15 to the user's own apparatus 1000 through the network, and prints out the original document image data on the user's own apparatus 1000.²

However, it is respectfully submitted that the '069 patent fails to disclose a file management server that is configured to store and to correlatingly manage the file and the second password (associated with the file) transmitted from said file transmitting terminal.

¹ See '069 patent, column 1, lines 9-11.

² Id. at column 17, lines 13-28.

Rather, the '069 patent simply discusses that **a password is required to access a selected personal box**. The '069 password information **is associated with the respective personal box** in the memory in its own apparatus.³ Further, the '069 patent discusses that **the password is not required** when storing document data into a user's own box or another user's box, as in ordinary electronic mail.⁴ That is, the '069 patent simply discusses a password that is associated with, and used to access, a personal box. The '069 patent does not disclose storing a password that is *associated with the document data* and that is *transmitted with the document data*.

Thus, the '069 patent does not disclose the file management server recited in Claim 1. Further, it is respectfully submitted that the '993 and '408 applications fail to remedy the deficiencies of the '069 patent, as discussed above. Moreover, the Office Action does not cite the '993 and '408 applications for those deficiencies.

Further, the Office Action apparently acknowledges, and it is respectfully submitted that the '069 patent and the '993 application fail to disclose "[a] mobile terminal [that] is configured to transfer an address of a particular file receiving terminal that is permitted to access the file, to said file management server through the web page." Rather, the Office Action cites the '408 application for such a teaching. Thus, it is respectfully submitted that the '069 patent and the '993 application do disclose that in response to the request transmitted by said file receiving terminal, if an address of said file receiving terminal and the address of the particular file receiving terminal transferred by the mobile terminal are determined to match, and if the request transmitted by said file receiving terminal is determined to include the second password, said file management server is configured to transfer the file to said file receiving terminal, as defined in Claim 1.

³ See '069 patent, column 15, lines 37-60.

⁴ Id. at column 13, lines 41-48.

The '408 application is directed to a print portal system on a network. In particular, the Office Action cites the '408 mobile phone for teaching the claimed "mobile terminal"; and the '408 transmission of a printer ID number from a client mobile phone to a printer portal PP for teaching a mobile terminal that is configured to "transfer an address of a particular file receiving terminal that is permitted to access the file, to said file management server through the web page."⁵

However, it is respectfully submitted that the '408 application fails to disclose in response to the request transmitted by said file receiving terminal, if an address of said file receiving terminal and the address of the particular file receiving terminal transferred by the mobile terminal are determined to match, and if the request transmitted by said file receiving terminal is determined to include the second password, said file management server is configured to transfer the file to said file receiving terminal. Rather, the '408 application simply discusses that there are four major processes for designating a printer as the desired output resource, referred to as cases A-D. In case A, the user recognizes the ID number allocated to each printer and transmits the ID number from the client mobile phone to the print portal PP. In case B, the print portal PP provides a list of printers, and the user selects a desired output resource out of the printer list. In case C, information for identifying the client or the user is input on a panel attached to the printer. Further, in case D, a user inputs a job number into the printer of the output source.⁶ That is, the '408 application simply discusses that a print job is provided to a printer based on a designation of the printer **at either the client mobile phone or the printer**. The '408 application does not disclose that a file is transferred to the printer in response *to a request transmitted by the printer*, if an address of said printer and *the address of the particular file receiving terminal transferred to the file management server by the client mobile phone are determined to match*.

⁵ See Office Action dated December 24, 2008, pages 9-11.

⁶ See '408 application, paragraphs [0341]-[0348].

Thus, no matter how the teachings of the '069 patent, the '993 application, and the '408 application are combined, the combination does not teach or suggest the file management server defined in Claim 1. Accordingly, it is respectfully submitted that Claim 1 (and all associated dependent claims) patentably defines over any proper combination of the '069 patent, the '993 application, and the '408 application.

Claim 11 recites, in part,

a first storage unit configured to store a file and a second password as part of an authorization condition for accessing said file related to each other, the second password being associated with the file; and

a file transferring unit configured to, in response to a request for transferring said file stored in said first storage unit from said file receiving terminal, transfer said file to said file receiving terminal if an address of said file receiving terminal and the address of the particular file receiving terminal transmitted from the mobile terminal are determined to match, and if the request for transferring said file is determined to include the second password.

As noted above, the '069 patent, the '993 application, and the '408 application, alone or in proper combination, fail to disclose the file management server defined in Claim 1. Thus, the '069 patent, the '993 application, and the '408 application fail to disclose the file management server recited in Claim 11. Accordingly, it is respectfully submitted that Claim 11 (and all associated dependent claims) patentably defines over any proper combination of the '069 patent, the '993 application, and the '408 application.

Claims 20 and 21 recite, in part,

storing a file and a second password as part of an authorization condition for accessing the file transmitted by said file transfer terminal through the web page, the second password being associated with the file; and

in response to the request, transmitting said file to said file receiving terminal if an address of said file receiving terminal and the address of the particular file receiving terminal transmitted from the mobile terminal are determined to match,

and if the request for transmitting said file is determined to include the second password.

As noted above, the '069 patent, the '993 application, and the '408 application, alone or in proper combination, fail to disclose the file management server recited in Claim 1. Thus, the '069 patent, the '993 application, and the '408 application fail to disclose the file transfer method defined in Claims 20 and 21, respectively. Accordingly, it is respectfully submitted that Claims 20 and 21 patentably define over any proper combination of the '069 patent, the '993 application, and the '408 application.

Claim 22 recites, in part,

said stored document management server is configured to store and to correlatingly manage the transmitted stored document and the second password transmitted from the first image forming apparatus; and

in response to the request transmitted by the second image forming apparatus, if an address of said second image forming apparatus and the address of the particular image forming apparatus transferred by the mobile terminal are determined to match, and if the request for transferring the document is determined to include the second password, said stored document management server is configured to transfer the stored document to said second image forming apparatus.

As noted above, the '069 patent, the '993 application, and the '408 application, alone or in proper combination, fail to disclose the file management server recited in Claim 1. Thus, the '069 patent, the '993 application, and the '408 application fail to disclose the stored document management server defined in Claim 22. Accordingly, it is respectfully submitted that Claim 22 patentably defines over any proper combination of the '069 patent, the '993 application, and the '408 application.

Claim 23 recites, in part,

a first storage unit configured to store a stored document and a second password as part of an authorization condition for accessing said stored document, the second password being associated with the stored document; and

a stored document transferring unit configured to, in response to a request for transferring said stored document stored in said first storage unit from said second image forming apparatus, transfer said stored document to said second image forming apparatus if an address of said second image forming apparatus and the address of the particular image forming apparatus transmitted from the mobile terminal is determined to match, and if the request for transferring said stored document includes the second password.

As noted above, the '069 patent, the '993 application, and the '408 application, alone or in proper combination, fail to disclose the file management server recited in Claim 1. Thus, the '069 patent, the '993 application, and the '408 application fail to disclose the stored document management server defined in Claim 23. Accordingly, it is respectfully submitted that Claim 23 patentably defines over any proper combination of the '069 patent, the '993 application, and the '408 application.

Claim 24 is directed to an image forming system, comprising:

a first image forming apparatus configured to manage a transfer of stored documents and to allow the stored documents to be accessed subject to a first password, and to store a stored document and a second password for accessing the stored document, the second password being associated with the stored document;

a user terminal; and

a second image forming apparatus;

wherein

said first image forming apparatus, said user terminal, and said second image forming apparatus are connected to each other via a network;

in response to a request from said user terminal, said first image forming apparatus is configured to, if the request from said user terminal is determined to include the second password, transmit said stored document and said second password as a part of an authorization condition for accessing the stored document to said second image forming apparatus; and

said second image forming apparatus is configured to store said stored document and said second password

associated with and, if a received request for printing said stored document is determined to include said second password, to print said stored document.

Regarding the rejection of Claim 24 under 35 U.S.C. § 103(a), as noted above, the '069 patent is directed to an image forming system including an image forming apparatus that communicates with other apparatuses for data exchange.⁷ In particular, the Office Action cites the '069 PC, which selects between allowing the image-forming apparatus to immediately print the image data or to store in the hard disk of the image-forming apparatus rather than immediately printing the image data, for teaching the claimed "user terminal." Further, the Office Action appears to cite the '069 personal box password for teaching the claimed "first password" and "second password."⁸

However, it is respectfully submitted that the '069 patent fails to disclose that in response to a request from said user terminal, said first image forming apparatus is configured to, if the request from said user terminal is determined to include the second password, transmit said stored document and said second password (associated with the stored document) as a part of an authorization condition for accessing the stored document to said second image forming apparatus. Rather, as noted in the Office Action, the '069 patent simply discusses that the PC can select between two options, i.e., print immediately or store in a hard disk. The Office Action asserts that "[t]hus in view of the user being able to issue print commands from his PC it would be obvious to give the user the ability to issue the command to print the document at another image-forming apparatus."⁹

Even assuming *arguendo* that "it would be obvious to give the user the ability to issue the command to print the document at another image-forming apparatus," such a command would not cause a first image apparatus ***to transmit a stored document and second password*** to a second image forming apparatus. Rather, the PC would appear to transfer the print

⁷ See '069 patent, column 1, lines 9-11.

⁸ See Office Action dated December 24, 2008, pages 31-33.

⁹ Id. at pages 32 and 33.

command directly to another image-forming apparatus. Further, as noted above, the '069 patent simply discusses a password that is associated with a personal box. The '069 patent does not disclose a password that is related to the stored document.

Thus, the '069 patent does not disclose the first image forming apparatus defined in Claim 24. Accordingly, it is respectfully submitted that Claim 24 patentably defines over the '069 patent.

Claim 25 recites, in part,

in response to a request from said user terminal, said first image forming apparatus is configured to, if the request from said user terminal is determined to include said second password, transmit said stored document and said second password as part of an authorization condition to said stored document management server.

As noted above, the '069 patent fails to disclose the first image forming apparatus recited in Claim 24. Thus, the '069 patent fails to disclose the first image forming apparatus recited in Claim 25. Accordingly, it is respectfully submitted that Claim 25 patentably defines over the '069 patent.

Claim 26 recites, in part,

a storage unit configured to store the stored document and the second password associated with the stored document as part of an authorization condition for accessing said stored document received from said other image forming apparatus.

As noted above, the '069 patent fails to disclose the first image forming apparatus recited in Claim 24. Thus, the '069 patent fails to disclose the image forming apparatus defined in Claim 26. Accordingly, it is respectfully submitted that Claim 26 (and all associated dependent claims) patentably defines over the '069 patent.

Claim 30 recites, in part,

said communication unit is configured to, in response to reception of a request for transmitting said stored document from said user terminal, if the request for transmitting said stored document is determined to include the second password,

transmit said stored document and said second password to said stored document management server.

As noted above, the '069 patent fails to disclose the first image forming apparatus recited in Claim 24. Thus, the '069 patent fails to disclose the image forming apparatus defined in Claim 30. Accordingly, it is respectfully submitted that Claim 30 patentably defines over the '069 patent.

Regarding the rejections of dependent Claims 3, 5, 6-8, 13, and 15-18 under 35 U.S.C. § 103(a), it is respectfully submitted that the '812 patent fails to remedy the deficiencies of the '069 patent, the '993 application, and the '408 application, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 3, 5, 6-8, 13, and 15-18 patentably define over any proper combination of the '069 patent, the '993 application, the '408 application, and the '812 patent.

Regarding the rejections of dependent Claims 4 and 14 under 35 U.S.C. § 103(a), it is respectfully submitted that the '618 patent fails to remedy the deficiencies of the '069 patent, the '993 application, and the '408 application, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 4 and 14 patentably define over any proper combination of the '069 patent, the '993 application, the '408 application, and the '618 patent.

Regarding the rejection of dependent Claim 9 under 35 U.S.C. § 103(a), it is respectfully submitted that the '010 application fails to remedy the deficiencies of the '069 patent, the '993 application, and the '408 application, as discussed above. Accordingly, it is respectfully submitted that dependent Claim 9 patentably defines over any proper combination of the '069 patent, the '993 application, the '408 application, and the '010 application.

Regarding the rejection of dependent Claim 19 under 35 U.S.C. § 103(a), it is respectfully submitted that the '618 patent and the '010 application fail to remedy the

deficiencies of the '069 patent, the '993 application, and the '408 application, as discussed above. Accordingly, it is respectfully submitted that dependent Claim 19 patentably defines over any proper combination of the '069 patent, the '993 application, the '408 application, the '618 patent, and the '010 application.

CONCLUSION

Thus, it is respectfully submitted that independent Claims 1, 11, 20, 21-26, and 30 (and all associated dependent claims) patentably define over any proper combination of the '069 patent, the '993 application, the '408 application, the '812 patent, the '618 patent, and the '010 application.

Consequently, in view of the present amendments and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

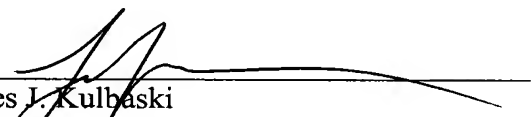
Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413 -2220

(OSMMN 03/06)


James I. Kulbaski
Attorney of Record
Registration No. 34,648

Johnny Ma
Registration No. 59,976